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Marilyn S. Bullock

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EXAMINER

MURDOUGH, JOSHUA A

ART UNIT

PAPER NUMBER

3621

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/707,476	<b>Applicant(s)</b> BULLOCK ET AL.	
	<b>Examiner</b> JOSHUA MURDOUGH	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Acknowledgements***

1. Applicants' amendments to the claims and specification, received on 3 March 2008 have been entered.
2. Accordingly, claims 1-36 are pending.
3. The Examiner has referenced three press releases regarding the same product. These press releases (From Panda Security Internacional; dated Jan. 17, 2001; Nov. 15, 2001; and Nov. 26, 2002) all reference a single embodiment ("Panda ActiveScan" 4.0), but when cited, the Examiner has referred to them chronologically as "Release 1," "Release 2," and "Release 3." (MPEP 2131.01)

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Panda ActiveScan in view of Dent (6,311,171).
6. As to claims 1, 13, and 22; Panda ActiveScan shows:

A method of disabling malicious code residing on a customer computer system in association with providing on-line financial services to a customer through a network, the method comprising:

presenting to the customer an option to perform a scan of the customer computer system for the malicious code (Release 3, Paragraph 7);

executing, at least in part by activation over the network (Release 3, Paragraph 5) and upon receiving from the customer a selection of the option to perform the scan, computer program instructions for performing the scan, the computer program instructions being directed to detection and disablement of the malicious code (Release 3, Paragraph 3);

Furthermore, Panda ActiveScan shows that the malicious code detection can be associated with other on-line services (Release 3, Paragraph 7).

Panda ActiveScan does not expressly show:

the other on-line service is financial.

authenticating the customer for the on-line financial services;

providing the on-line financial services to the customer.

Dent shows authenticating a customer through use of public key/private key encryption in order to process an online financial transaction (Figure 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention Panda ActiveScan to reside on the website of a financial institution, because webmasters were invited to include the functionality (Panda ActiveScan; Release 3, Paragraph 7) and security at a financial institution is a major concern.

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7. As to claim 2, 14, and 23; Panda ActiveScan further shows:

the executing of the computer program instructions further comprises downloading the computer program instructions to the customer computer system (Release 1, Paragraphs 8-10).

8. As to claim 3, 15, and 24; Panda ActiveScan further shows:

the executing of the computer program instructions is accomplished at least in part through the use of an ActiveX control (Release 1, Paragraph 7).

9. As to claim 4, 16, and 25; Panda ActiveScan further shows:

the computer program instructions are operable to perform signature-based detection of the malicious code (Release 2, Paragraph 7).

10. As to claim 5, 17, and 26; Dent, in the combination above, shows:

the computer program instructions are operable to perform integrity checking (Through keys, as mentioned; Figure 2).

11. As to claim 6, 18, and 27 Panda ActiveScan further shows:

the computer program instructions are operable to perform non-integrity-based unknown malicious code detection (Heuristic scan engine; Release 3, Paragraph 2).

12. As to claim 7, 19, and 28; Panda ActiveScan further shows:

the computer program instructions are operable to perform signature-based detection of the malicious code (Release 2, Paragraph 7).

13. As to claim 8, 20, and 29; Dent, in the combination above, shows:

the computer program instructions are operable to perform integrity checking (Through keys, as mentioned; Figure 2).

14. As to claim 9, 21, and 30; Panda ActiveScan further shows:

the computer program instructions are operable to perform non-integrity-based unknown malicious code detection (Heuristic scan engine; Release 3, Paragraph 2).

15. As to claim 10, Panda ActiveScan shows:

Apparatus for disabling malicious code residing on a customer computer system in association with providing on-line financial services to a customer through a network, the apparatus comprising:

means for executing, at least in part by activation over the network (Release 3, Paragraph 5), computer program instructions for performing a scan for the malicious code, the computer program instructions being directed to detection and disablement of the malicious code (Release 3, Paragraph 3);

Panda ActiveScan does not expressly show:

means for authenticating the customer for the on-line financial services;

means for providing the on-line financial services to the customer.

Dent shows authenticating a customer through use of public key/private key encryption in order to process an online financial transaction (Figure 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention Panda ActiveScan to reside on the website of a financial institution, because webmasters were invited to include the functionality (Panda ActiveScan; Release 3, Paragraph 7) and security at a financial institution is a major concern.

16. As to claim 11, Panda ActiveScan further shows:

the means for executing the computer program instructions further comprises means for downloading the computer program instructions to the customer computer system (Release 1, Paragraphs 8-10).

17. As to claim 12, Panda ActiveScan further shows:

the means for executing the computer program instructions further comprises an ActiveX control (Release 1, Paragraph 7).

18. While treated together and the method limitations directly addressed, it is recognized that claims 13-21 are to the software and 22-30 are to the system. The software instructions claimed

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would cause a computer to perform the noted method if they were caused to execute. Also, the system claimed would also need to be present to perform the associated method.

19. Claims 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Panda ActiveScan and Dent as applied to claims 1, 3, 10, 13, 15, and 22 above, and further in view of Applicants' Admitted Prior Art.

20. For each claim (31-36), all of the elements of the parent claim have been shown by Panda ActiveScan and Dent above.

Panda ActiveScan and Dent do not expressly show:

the executing of the computer program instructions for performing the scan further comprises making reference to a database of code that the customer has previously identified as safe.

However, Applicants show in paragraph [0019] of their specification that this is part of a known method of scanning performed by Norton TM Anti-virus.

As multiple methods of scanning for viruses were known at the time of the invention, selecting any one of them would have been obvious to one of ordinary skill in the art at the time of the invention because it would simply be the implementation of a known procedure to produce a known result. Moreover, the use of "inoculation," as termed by Symantec Corp. (Specification, paragraph [0019]), would have been a preferred choice because it provides for faster subsequent scans because only the fingerprint is scanned to provide a reasonable level of assurance that the content is still safe.



### ***DEFINITIONS***

To the extent that the Examiner's interpretations are in dispute with Applicants' interpretations, the Examiner hereby adopts the following definitions—under the broadest reasonable interpretation standard—in all his claim interpretations. Moreover, while the following list is provided in accordance with *In re Morris* 127 F.3d 1056, 44 USPQ2d 1029 (Fed. Cir. 1997), the definitions are a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

**Associate.** “to combine or join with other parts” Webster's Ninth New Collegiate Dictionary. 1986, Merriam-Webster Inc.

### ***Response to Arguments***

Applicant's arguments filed 3 March 2008 have been fully considered but they are not persuasive.

#### **Applicants argue:**

Claim 22 as originally filed, as well as claims 1, 10 and 13 as amended, all recite the detection and/or disablement of malicious code on a customer computer "in association with..., providing the on-line financial services." The detection of malicious code *in association with the provision of on-line financial services* allows a financial institution to extend its security perimeter around a customer when the customer is performing on-line transactions.

Examiner's response:

The Examiner agrees that the claims recite that the detection and/or disablement of malicious code on a customer computer in association with on-line financial services. However, the claims do not recite Applicants' argued interpretation. Applicants have not provided an express definition of association, therefore the Examiner has relied upon a definition known in the art (associate, see Definitions above) when interpreting these claims. In view of the definition provided, clearly the virus scan and financial transactions are joined by being on the same website. If Applicants desire the above stated interpretation, they are encouraged to include claim language discussing, for example, the security perimeter, to the extent it is supported by the specification.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Because this application is now final, Applicant(s) are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112 1<sup>st</sup> paragraph written description and enablement, §112 2<sup>nd</sup> paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J. M.

Examiner, Art Unit 3621

/ANDREW J. FISCHER/

Supervisory Patent Examiner, Art Unit 3621